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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,152	10/31/2005	Andreas Muth	HER07 P-450	2552
277 7590 03/18/2009 PRICE HENEVELD COOPER DEWITT & LITTON, LLP 695 KENMOOR, S.E. P O BOX 2567 GRAND RAPIDS, MI 49501				
EXAMINER				
BUTLER, PATRICK NEAL				
ART UNIT		PAPER NUMBER		
1791				
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03/18/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/539,152

## Applicant(s)

MUTH ET AL.

## Examiner

Patrick Butler

## Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 41, 43, 44 and 46-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41, 43, 44 and 46-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant's Amendments, filed on 02 October 2008, and Accompanying Remarks, filed on 14 August 2008 and 02 October 2008, have been entered and have been carefully considered. The Applicant's Amendments, filed on 20 February 2008, and Accompanying Remarks, filed on 09 January 2008 and 20 February 2008, have been entered and have been carefully considered. Applicant indicates the Claims and Remarks are directed to Application number 11/539,152 in Applicant's Amendments, filed on 02 October 2008 and 20 February 2008, and Accompanying Remarks, filed on 02 October 2008, 14 August 2008, 20 February 2008, and 09 January 2008. However, the Examiner assumes their filing to be for Application Number 10/539,152 as indicated on Page 1 of Applicant's response filed on 02 October 2008.

### ***Election/Restrictions***

Applicant's election of Group II claims 41-48, in the replies filed on 14 August 2008 and 02 October 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 41, 44, and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison et al. (US Patent No. 2,997,096) in view of Eriksson et al. (International Publication Number WO 00/44540).

With respect to Claim 41, Morrison teaches making a glass wool pack with an uncured binding agent (a method of producing insulation elements made of mineral wool containing a curable binder) by delivering a fibrous glass web 16 and an uncured binding agent onto a conveyor 18 (depositing insulation material comprising mineral wool and a curable binder on a conveyor) into and through a curing oven 30 (curing and transporting the insulation material through a tunnel furnace) where it is brought down to its desired thickness from four inches to two inches by the compression conveyor 32 during curing (subjecting sections of the insulation material to controlled compaction in such a manner that at least one permanent impression and/or deformation is produced in the insulation blanket while the insulation blanket is curing during its passage through the tunnel furnace; wherein the insulation is provided with a profile during curing) (see fig. 1 and col. 3, lines 5-35 and 60-70).

Morrison does not appear to expressly teach shaping the pack into a non-rectangular cross-sectional profile.

Eriksson teaches shaping a fiber mat 3 by compressing with profiled cutting roll 6 and steam roll 7 having varying diameters (see page 2, lines 14-26 and fig. 1), which would compact more in the parallel channels of higher diameter on the cutting roll 6 and steam roll 7 (wherein the insulation is provided with a non-rectangular cross-sectional profile).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Eriksson's shaping roll 7 in Morrison's method of making a fibrous mass in order to make a profiled product without having to shape post-curing (see Eriksson, page 1, lines 20-28 and page 3, lines 21-26).

With respect to Claim 44, the product is a glass wool pack (the mineral wool is glass wool) (see col. 3, lines 5-11).

With respect to Claims 46-48, Eriksson teaches shaping a fiber mat 3 by compressing with profiled cutting roll 6 and steam roll 7 having varying diameters (see page 2, lines 14-26 and fig. 1), which would compact more in the parallel channels of higher diameter on the cutting roll 6 and steam roll 7 (cross-sectional profile comprises at least one depression or projection; the cross-sectional profile of the insulation element displays two parallel recesses in one surface; during the step of subjecting the sections of the insulation to controlled compaction, the insulation material is compacted to varying degrees, whereby a density within the insulation elements varies accordingly).

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison et al. (US Patent No. 2,997,096) in view of Eriksson et al. (International Publication Number WO 00/44540) as applied to claim 41 above, and further in view of Collins (US Patent No. 2,288,072).

With respect to Claim 43, Morrison et al. teach a method of curing a fibrous mass as previously described. Morrison teaches a method of making the fibrous mass of

mineral material (see col. 9, line 55 through col. 10, line 5). Morrison does not appear to expressly teach that the mineral material is rock wool.

Collins teaches making bonded fibrous products of mineral wool such as glass wool or rock wool (see page 1 of text, left column, lines 1-20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Collins's rock wool with Morrison's method of making a mineral wool pack in order to provide a product of high temperature stability.

### ***Response to Arguments***

Applicant's arguments filed 14 August 2008 and 02 October 2008 have been fully considered but they are not persuasive.

Applicant argues with respect to the 35 USC § 103(a) rejections. Applicant's arguments appear to be on the grounds that:

1) It would not have been obvious to one of ordinary skill in the art at the time the invention was made to combine Morrison and Eriksson because they are non-analogous. Erikson does not relate to mineral wool and insulation, and Erikson uses steam rather than a furnace Technologies applicable to MDF like milling or sawing are not applicable to shaping mineral wool.

2) Eriksson's steam-injection press is not a tunnel furnace.

3) Forming technologies used with MDF such as milling and sawing are not applicable to mineral wool due to the stiffness of mineral wool.

The Applicant's arguments are addressed as follows:

1 and 3) In response to applicant's argument that Eriksson are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the references are both in the field of Applicant's endeavor: continuous shaping and curing of planar elements (see Specification, page 3, second paragraph; Eriksson, page 3, lines 21-26; and Morrison, fig. 1 and col. 3, lines 5-35), and Morrison is reasonably pertinent to the particular problem of avoiding secondary finishing processes (see Specification, page 2, second paragraph and Eriksson, page 1, lines 20-28 and page 3, lines 21-26).

2) Morrison teaches a curing oven 30 (a tunnel furnace) (see fig. 1 and col. 3, lines 5-35 and 60-70).

3) Although Applicant's discussion of the technological limitations to treating mineral wool have been considered, the arguments of counsel cannot take the place of evidence in the record.

3) Moreover, Applicant discloses that it was well known at the time the invention was made to cut and mill mineral wool panels (see Specification, page 1, paragraphs 2 and 4).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Butler whose telephone number is (571) 272-8517. The examiner can normally be reached on Mon.-Thu. 7:30 a.m.-5 p.m. and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. B./  
Examiner, Art Unit 1791

/Christina Johnson/  
Supervisory Patent Examiner, Art Unit 1791